

REMARKS

Claim 14, 41, 49 and 57 have been amended. No claims have been cancelled, and no new claims have been added. Claims 1-60 are pending.

Claim Rejections - 35 USC § 112

The Examiner rejected claims 41, 49 and 57 under 35 USC § 112, second paragraph as indefinite. The Examiner pointed out an inconsistent use of the terms “web browser” and “Internet web browser” in each of these claims. Claims 41, 49 and 57 have been amended to ensure that the term “web browser” or “Internet web browser” is used consistently within each of the claims. As such, this rejection is now moot and should be withdrawn.

Double Patenting

The Examiner rejected claims on the ground of nonstatutory double patenting over claims of USP 7,441,205. A terminal disclaimer is filed herewith to moot the rejection.

Though a terminal disclaimer has been filed, this should not be taken as a concession that the rejection was correct. To the contrary, it is believed that the cited claims are patentably distinct. Because the application was been pending for over 4 years before the first Office Action was mailed, expedience is now in the greatest interest of the assignee of the application. The terminal disclaimer is filed because it presents the path of least resistance. That is, by filing the terminal disclaimer, all of the claims in the application will be in a condition for allowance. Thus, further delays arising from arguing the rejection are avoided, as are the considerable costs of making the arguments. Of course, the terminal disclaimer comes at the cost of a loss of term. Yet, by forgoing a few months at the end of the patent's term, precious months are gained at the beginning of the term. This is an excellent compromise, and is the sole motivation for the terminal disclaimer.

Claim Rejections - 35 USC § 102

The Examiner rejected claims 1-60 under 35 USC § 102(e) as anticipated by Cho *et al.* (USP 6,834,048). This rejection is respectfully traversed.

Cho discloses a VOIP telephone system which allows a computer user to call through a computer to a telephone call recipient. Only two devices are involved in the teachings of Cho, a computer and the recipient's telephone or computer. As disclosed in Cho, Cho

provides audio communication between a personal computer 11 and an audio communication device 14. In operation, a local caller using computer 11, equipped with a sound card and headset, for example, uses a web browser to access and log onto web site 16 of an internet telephone service provider. After logging-on, the local caller provides the phone number of regular telephone 14 to web site 16, which then directs an Internet Telephone Service Provider (ITSP) gateway 12 to provide a voice connection between computer 11 and telephone 14.

Cho, 3:6-15.

All of the independent claims, namely claims 1, 21, 33, 37, 38, 41, 49 and 57, recite a toolbar or toolbar software, a computing device, a first telephone and a second telephone.

We respectfully remind the examiner that each and every one of the claimed limitations must be disclosed in the cited reference for a § 102 anticipation rejection. MPEP 2131. And, importantly, the Federal Circuit recently emphasized that to show anticipation a reference must disclose "not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim". *Net MoneyIn, Inc. v. Verisign, Inc.* 545 F.3d 1359, 1371 (Fed. Cir. 2008)

Cho fails to disclose all of the claimed limitations. As such, all of the claims are patentable over Cho. The following paragraphs set forth specifically how Cho fails to disclose each and every one of the claimed limitations.

We earlier argued that Cho fails to teach a system that involves three devices as claimed. All of the independent claims recite a computing device, a first telephone and a second telephone. Cho is limited to a system that involves two devices. Cho's system involves a computer from which a telephone call is placed and a recipient telephone (or computer). This is made clear at 3:6-15 of Cho (quoted above) and at Cho 6:44-65. As such, Cho fails to teach a system that involves three devices as claimed. The Examiner has not addressed this in the current Office Action.

Moreover, claims 41, 49 and 57 have been amended to replace the term "distinct" with "independent". We assert that this emphasizes that three independent devices are recited in the claims. This is important because in Cho, only two devices are taught. Because Cho is limited to teaching a PC communicating to a telephone (or other PC), Cho does not teach the claimed computing device, first telephone and second telephone. As such, claims 41, 49 and 57 are patentable over Cho for this additional reason.

Additionally, all of the independent claims (claims 1, 21, 33, 37, 38, 41, 49 and 57) recite a computing device, a first telephone having a first telephone number and a second telephone having a second telephone number. There is no teaching in Cho of two telephone numbers involved in the system disclosed therein. Cho's system is limited to a single PC that calls a recipient phone (or PC) associated with a phone number. (Cho, 3:7-14, 6:44-65) The cited portions of Cho that are asserted as teaching a second telephone number do not teach a second telephone number. These teaching are limited to a single PC that calls a recipient phone have an associated phone number via a service provider. (Cho, Fig. 4, 6:44-65) Because Cho does not disclose a computing device, a first telephone having a first telephone number and a second telephone having a second telephone number, Cho does not disclose each and every one of the limitations recited in the independent claims. Therefore, the independent claims are patentable over Cho.

Further, claims 1, 33, 37, 41 and 57 explicitly recite a two leg call between a predefined telephone number and the activated telephone number wherein the predefined telephone number is associated with a first telephone distinct or independent from the computing device that runs the

(Internet) web browser, and wherein the activated telephone number is associated with a second telephone distinct or independent from the computing device and distinct or independent from the first telephone. We earlier asserted that Cho fails to teach the claimed two leg telephone call. That is, as claimed, the two leg call is initiated from a computer or computing device, but the two leg call is between a first telephone and a second telephone wherein the first telephone is distinct or independent from the computing device that runs the web browser, and wherein the activated telephone number is associated with the second telephone distinct or independent from the computing device and distinct or independent from the first telephone. We maintain our assertion that Cho does not teach such a two leg call. The Examiner has not addressed this in the current Office Action.

That the Examiner asserts “the claims do not recite that the first telephone is ‘physically separated’ from the computing device that runs the Internet web browser” in no way changes the analysis of and conclusion reached in the above paragraph. Regardless of whether “the first telephone is ‘physically separated’ from the computing device”, Cho nonetheless fails to disclose the claimed two leg call limitation recited in claims 1, 33, 37, 41 and 57.

We direct the Examiner to consider certain of the dependent claims that recite that the first telephone is “physically separate” from the computing device. We direct the Examiner to consider claims 4, 24, 44 and 51 which recite that the adjacent telephone is a cellular telephone. Based on the Examiner’s finding that physically separate is important, we assert that dependent claims 4, 24, 44 and 51 are therefore patentable over Cho.

As to claim 4, 24, 44 and 51, the Examiner cites to a teaching in Cho that a telephone number is assigned to the computing device (Cho, 3: 6-21) The Examiner cites to portions of Cho that teach a telephone system that includes wired and wireless connections between two devices, [1] an initiating PC having on the one hand and [2] a recipient telephone or computer having an associated phone number on the other. This disclosure in Cho in no way teaches that the claimed first/adjacent telephone is a cellular telephone that is distinct or independent of the computing device and distinct

or independent of the second telephone. As such, Cho does not disclosed all of the limitations recited in claims 4, 24, 44 and 55. Therefore, claims 4, 24, 44 and 55 are patentable over Cho.

Returning to a discussion of claims 1, 33, 37, 41 and 57. The Examiner asserts that duplex communications teaches a two leg phone call. This is not so. Duplex communications refers to the transmission of data in two directions simultaneously, that is, two-way communications. Duplex communications does not disclose a two leg call between a predefined telephone number and the activated telephone number wherein the predefined telephone number is associated with a first telephone distinct from the computing device that runs the web browser, and wherein the activated telephone number is associated with a second telephone distinct from the computing device and distinct from the first telephone. Duplex communications does not disclose the two leg call limitation recited in claims 1, 33, 37, 41 and 57.

Further, we reiterate our assertion that Cho fails to teach a toolbar of any kind. Independent claims 1, 21, 33, 37 and 38 recite “the toolbar software causing a toolbar to be displayed in the web browser on the computing device” or “the toolbar software causing a toolbar pane to be displayed in the web browser on the computing device”. And independent claims 41, 49 and 57 recite “computer software distinct from a web browser and to operate as a toolbar in the web browser”. There is no teaching of the toolbar software limitation in Cho. Cho is limited to teaching a web browser and a “browser level application” that acts cooperatively with the web browser. (Cho, 4:14-24 and 4:50 - 5:65) The teaching of an Internet web browser and cooperative application does not teach a toolbar that is displayed in a web browser or toolbar software that operates in a web browser as claimed. As such, Cho fails to disclose the toolbar software limitations recited in the independent claims, namely claims 1, 21, 33, 37, 38, 41, 49 and 57.

In view of the prior paragraphs, Cho fails to teach all of the limitations recited in the independent claims. Therefore, all of the independent claims, and all claims depending thereon, are patentable over Cho. As such, all claims are patentable over Cho and this rejection should be withdrawn.

In addition, independent claims 21 and 49 recite, among other limitations, in pertinent part, “the toolbar software scanning the web page data for associated data items included in an address book stored on the computing device and included with or accessible to the toolbar”, “identifying the associated data items found in the web page data as found data items” and “pairing a telephone number from the address book with each of the found data items”, as well as other actions involving “associated data items” and an “address book”. And independent claim 38 recites, among other limitations, the toolbar software “identifying telephone numbers in the web page data as identified telephone numbers”, “looking up the identified telephone numbers in an address book stored on the computing device to create a found telephone numbers list” and “altering the normal display of at least one of the found telephone numbers to make the found telephone number conspicuous on the web page in which the found telephone number is included”.

Claims 21, 38 and 49 specify that the address book is stored on the computing device. The cited portion of Cho merely shows a yellow pages web site search results page. (Cho FIGS. 5A and 5B, 6:36-40) Cho does not teach “an address book stored on the computing device” as claimed. As such, Cho fails to teach all of the limitations recited in independent claims 21, 38 and 49. Therefore, claims 21, 38 and 49 and all claims depending thereon are patentable over Cho.

Claim Rejections - 35 USC § 103

The Examiner rejected claims 1-60 under 35 USC § 103(a) as obvious in view of Cho *et al.* and “official notice”. This rejection is respectfully traversed.

The Examiner rejects Claim 1-60 under both 102(e) anticipation and 103(a) obviousness. This is strange because if claims 1-60 are asserted to be taught by Cho, then the 103(a) obviousness rejection is moot. If the 103(a) obviousness rejection is maintained, then we assert that the Examiner has admitted that Cho does not anticipate claims 1-60 under 102(e). The Examiner cannot have it both ways.

A new non-final office action is requested clarifying which rejection the Examiner intended to make, 102(e) anticipation or 103(a) obviousness.

In the obviousness rejections, the Examiner takes “official notice” of various well known personal computer components and telephones. The Examiner then states that “It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Cho to include old and well-known teachings of telephones distinct from the computing device to make telephone calls” and other teachings such as address books on PCs. However, it is unclear what “old and well-known teachings of telephones distinct from the computing device” the Examiner is asserting are to be combined with Cho. We seek clarification.

Moreover, “official notice” of basic, well known personal computer components such as modems, sound cards and address books does not cure the deficiencies of Cho described above in response to the 102(e) anticipation rejection.

Because the disclosure of Cho in view of “official” notice do not teach each and every one of the limitations recited in the claims, all claims are not rendered obvious by and are patentable over Cho in view of “official notice”.

Disclaimers Relating to Claim Interpretation and Prosecution History Estoppel

The claims of this application are intended to stand on their own and are not to be read in light of the prosecution history of any related or unrelated patent or patent application. Furthermore, no arguments in any prosecution history relate to any claim in this application, except for arguments specifically directed to the claim.

Conclusion

It is submitted, however, that the independent and dependent claims include other significant and substantial recitations which are not disclosed in the cited references. Thus, the claims are also patentable for additional reasons. However, for economy the additional grounds for patentability are not set forth here.

In view of all of the above, it is respectfully submitted that the present application is now in condition for allowance. Reconsideration and reexamination are respectfully requested and allowance at an early date is solicited.

The Examiner is invited to call the undersigned registered practitioner to answer any questions or to discuss steps necessary for placing the application in condition for allowance.

Respectfully submitted,



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